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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,045	09/29/2003	Jung-Tao Liu	LIU-24/2100.004200	2585

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EXAMINER

ALAM, FAYYAZ

ART UNIT	PAPER NUMBER
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2618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/674,045	Applicant(s) LIU, JUNG-TAO	
	Examiner Fayyaz Alam	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to applicant's amendment/arguments filed on 1/30/2007. **This action is made FINAL.**

Response to Arguments

Applicant's arguments with respect to claims 1 - 27 have been considered but are moot in view of the new ground(s) of rejection.

Applicant primarily argues claims 1 and 17, examiner respectfully disagrees and traverses the argument. See rejection of claims 1 and 17 below.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by **Tiedemann et al. (USPN 6,982,971)**.

Consider **claims 1 and 17**, Tiedemann et al. disclose a method for controlling a communication system and a mobile device (see abstract), comprising: MS establishing link (read as communicating) with BTS1 (read as first base station) and BTS2 (read as second base station) using same frame offset (read as first synchronizing signal) used by BTS1 while in the handoff region (see col. 10, lines 4 - 10; col. 10, line 65 - col. 11, line 5; col. 11, lines 21 - 23; see fig. 1A); communicating with BTS 1 and BTS2 (read as concurrently with a plurality of base stations including first base station) during handoff using the same frame offset (read as first synchronization signal); and communicating with BTS2 using the adjusted reverse link demodulation timing (read as second synchronization signal) after handoff direction message is sent (read as after the handoff period) (see col. 11, lines 28 - 38).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 - 13 and 18 - 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tiedemann et al. (USPN 6,982,971)** in view of **Blackeney II et al. (U.S. Patent # 5,267,261)**.

Consider **claims 2 and 18** as applied to claims 1 and 17, Tiedemann fails to disclose said claims.

In the related field of endeavor, Blackeney discloses synchronization signals being transmitted from the base stations in the active set and received at the mobile station, where the mobile station is in communication with at least one base station (read as first synchronizing signal is delivered from a first base station to mobile device; see col. 3, lines 45 - 68).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Tiedemann with the teachings of Blackeney in order to perform handoff.

Consider **claims 3 and 19** as applied to claims 1 and 17, Tiedemann fails to disclose said claims.

In the related field of endeavor, Blackeney discloses when there is only one base station remaining in the active set the mobile station is in communication with that base station and is therefore no longer in the hand off period and is inherently synchronized with the one remaining base station (read as the second synchronizing signal is delivered from a second base station to a mobile device see col. 4, lines 31 - 35).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Tiedemann with the teachings of Blackeney in order to perform handoff.

Consider **claims 4 and 20** as applied to claims 1 and 17, Tiedemann fails to disclose said claims.

In the related field of endeavor, Blackeney discloses the mobile station monitors and receives pilot signals (read as signals reflecting parameters of communication) from multiple base stations while in communication with at least one base station (read as receiving signals reflecting parameters of communication between a mobile device and a second base station; see col. 3, lines 45 - 68).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Tiedemann with the teachings of Blackeney in order to perform handoff.

Consider **claims 5, 6, and 21** as applied to claims 4 and 20, respectively, Tiedemann fails to disclose said claims.

In the related field of endeavor, Blackeney discloses communication between a mobile station and a system controller via said at least one base station in communication where when a pilot signal of a base station exceeds a preset threshold it is eventually added to an active set and all the base stations in the active set are allowed to communicate with the mobile station. The mobile station is now in hand off period since there are more than one base stations in the active set (read as the hand off period is initiated in response to the parameters of communication between the mobile device and the second base station and the second base station is added to an active set associated with the mobile device, wherein each base station in the active set is permitted to communicate with the mobile device; see col. 3, lines 45 - 68; col. 4 lines 31 - 35).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Tiedemann with the teachings of Blackeney in order to perform handoff.

Consider **claim 7** as applied to claim 6, Tiedemann fails to disclose said claims.

In the related field of endeavor, Blackeney discloses the system controller communicates the active set to the mobile station (see col. 3, lines 45 - 68).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Tiedemann with the teachings of Blackeney in order to perform handoff.

Consider **claims 8, 9, 10, 22, and 23** as applied to claims 1, 8, 9, 17 and 22, respectively, Tiedemann fails to disclose said claims.

In the related field of endeavor, Blackeney discloses the at least one base station used for communication is in the active set where the pilot signals (read as receiving signals reflecting parameters of communication) of all the base stations are monitored and therefore when the pilot signal of that at least one base station (read as first base station) drops below a preset threshold, communication with that at least one base station (read as first base station) is terminated and it is removed from the active set while communication with remaining base stations in active set continues. If there were only two remaining base stations including the at least one base station (read as first base station) in the active set, communication is established with the remaining base station which results in a termination of the hand off period (read as receiving signals reflecting parameters of communication between a mobile device and a first base station and the hand off period is terminated in response to the parameters of communication between the mobile device and the first base station and the first base station is removed from an active set associated with the mobile device, wherein each base station in the active set is permitted to communicate with the mobile device; see col. 3, lines 45 - 68; col. 4 lines 1 - 14).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Tiedemann with the teachings of Blackeney in order to perform handoff.

Consider **claim 11** as applied to claim 10, Tiedemann fails to disclose said claims.

In the related field of endeavor, Blackeney discloses communicating the active set to the mobile station (see col. 4, lines 15 - 30).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Tiedemann with the teachings of Blackeney in order to perform handoff.

Consider **claims 12 and 24** as applied to claims 1 and 17, Tiedemann fails to disclose said claims.

In the related field of endeavor, Blackeney discloses communication of at least one base station (read as first base station) with the mobile station, therefore, the mobile station is synchronized with said base station (read as first synchronized signal). When there exists more than two base stations in the active set, the communication to the network is always carried out through the at least one base station from the mobile station. Therefore, communication to system controller in regards to adding base stations (read as second and third base stations) to an active set, based on pilot signal strength is carried out by the at least one base station (read as first base station) and thus first synchronizing signal is used during a hand off period (see col. 3, lines 45 - 68).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Tiedemann with the teachings of Blackeney in order to perform handoff.

Consider **claims 13 and 25** as applied to claims 12 and 24, Tiedemann fails to disclose said claims.

In the related field of endeavor, Blackeney discloses removing base stations from the active set and terminating communications with the removed base stations once pilot signals from base stations drop below a preset threshold. Therefore, once all the base stations are removed from the active set except for one, the hand off period is terminated and communication with other base stations is terminated as well and the mobile station is communicating using synchronizing signal from the last remaining base station (read as communicating from the second base station to the mobile device using signals synchronized with a second synchronizing signal after the hand off period further comprises communicating from the second base station to the mobile device using signals synchronized with the second synchronizing signal in response to communications with both the first and third base stations being ended; see col. 4, lines 1 - 35).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Tiedemann with the teachings of Blackeney in order to perform handoff.

Claims 14, 15, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tiedemann et al. (USPN 6,982,971)** in view of **Blackeney II et al. (U.S. Patent # 5,267,261)**.

Consider **claim 14, 15, 26, and 27** as applied to claims 13, 25, and 24, respectively, Tiedemann fails to disclose communicating from the second base station to the mobile device using signals synchronized with the second synchronizing signal in response to communications with the first base station and then the third base station being ended and communicating from the second base station to the mobile device using signals synchronized with the second synchronizing signal in response to communications with the third base station and then the first base station being ended.

Nevertheless, an active set comprise of base stations for potential hand off during a hand off period. Removing and terminating communication with a particular base station is a matter of what sort of priority the base stations are arranged in, in the active set. They can be arranged according to the strongest pilot signal, time of reception, etc. Therefore, removing a base station from an active set and terminating communications with it first as opposed removing and terminating communications with another base station is merely a matter of design choice according to the prioritization of the active set.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Tiedemann et al (USPN 6,982,971)** in view of **Blackeney II et al. (U.S. Patent # 5,267,261)** and further in view of **Sekine et al. (U.S. Application # 2001/0024429)**.

Consider **claim 16** as applied to claim 1, Tiedemann as modified by Blackeney fails to disclose a second base station retaining in memory the first synchronizing signal.

In the related field of endeavor, Sekine et al. disclose in a soft handover procedure transmitting a phase difference offset (OFS 1) (read as first synchronization signal) to base station (104) (read as second base station). Therefore, the OFS 1 signal would be stored in the base station (104) (read as a second base station retaining in memory the first synchronizing signal; [0069 - 0073]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Tiedemann and Blackeney with the teachings of Sekine et al. in order to provide efficiency in time by fast acquisition of synchronization information and avoid loss of data with unsynchronized base stations.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fayyaz Alam whose telephone number is (571) 270-1102. The Examiner can normally be reached on Monday-Friday from 9:30am to 7:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Edan Orgad can be reached on (571) 272-7884. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Fayyaz Alam

April 3, 2007

EDAN ORGAD
PRIMARY PATENT EXAMINER

Edan Orgad 4/1/07